

REMARKS/ARGUMENTS

The Office Action mailed 1/22/2004 has been carefully reviewed. Reconsideration of this application as amended and in view of the following remarks is respectfully requested. The claims presented for examination are: claims 1-11. The Office Action mailed 1/22/2004 is a Final Rejection.

Amendment Complies with Requirements of Form

37 CFR 1.116 (b) provides "After final action or other final action ... amendments may be made Complying with any requirement of form expressly set forth in a previous Office Action." This amendment strictly complies with requirements of form set out in the Office Action mailed 1/22/2004. Applicants believe that all of the requirements of form set out in the Office Action mailed 1/22/2004 have been addressed and the amended application is in condition for allowance.

Claim Objections

In numbered paragraph 6 of the Office Action mailed 1/22/2004, claim 11 was objected to because the word "on" should be changed to "one." Applicants have amended claim 11 to change the word "on" to "one."

35 USC 112, First Paragraph Rejection

In numbered paragraph 8 of the Office Action mailed 1/22/2004, claims 1-11 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

Numbered paragraph 8 of the Office Action mailed 1/22/2004 stated: In claim 1, at lines 11-13, the newly added recitation that "antibodies immobilized on said surface of said electrode plates and immobilized in said space between said interdigitated electrodes, wherein said pathogens carried by said fluid attach to said immobilized antibodies" is not supported by the specification, as

originally filed. It is suggested that lines 11-13 be deleted for claim 1. Applicants have amended claim 1 to deleted the recitation and claim 1 is believed to comply with the requirement of form set out in the Office Action and to overcome the 35 USC 112, first paragraph, rejection.

Numbered paragraph 8 of the Office Action mailed 1/22/2004 stated: In claim 8, at lines 12-14, the newly added recitation that "antibodies immobilized on said surface of said electrode plates and immobilized in said space between said interdigitated electrodes, wherein said pathogens carried by said fluid attach to said immobilized antibodies" is not supported by the specification, as originally filed. It is suggested that lines 12-14 be deleted for claim 8. Applicants have amended claim 8 to deleted the recitation and claim 8 is believed to comply with the requirement of form set out in the Office Action and to overcome the 35 USC 112, first paragraph, rejection.

35 USC 112, Second Paragraph Rejection

In numbered paragraph 10 of the Office Action mailed 1/22/2004, claims 1-11 were rejected under 35 USC 112, second paragraph, as being indefinite.

Numbered paragraph 10 of the Office Action mailed 1/22/2004 stated: In claim 1, at line 14, the term "across electrode plates" should be changed to "across said electrode plates." Numbered paragraph 10 of the Office Action mailed 1/22/2004 also stated: The same applies to claims 2-7. Applicants have amended claim 1 to change "across electrode plates" to "across said electrode plates" and claim 1 is believed to comply with the requirement of form set out in the Office Action and to overcome the 35 USC 112, second paragraph, rejection. Applicants have amended claims 4, 6, and 7 to change "the electrode plates" to "said electrode plates" and claims 4, 6, and 7 are believed to comply with the requirement of form set out in the Office Action and to overcome the 35 USC 112, second paragraph, rejection.

Numbered paragraph 10 of the Office Action mailed 1/22/2004 stated: Claim 8 is now indefinite because the term "said pathogens" at line 3 and bridging lines 13 and 14 lack positive antecedent support in claim 8 itself. It is suggested that "pathogens" at line 3 be changed to "particles." Applicants have amended claim 8 to change "pathogens" to "particles" and claim 8 is believed to comply with the requirement of form set out in the Office Action and to overcome the 35 USC 112, second paragraph, rejection. Numbered paragraph 10 of the Office Action mailed 1/22/2004 also stated: As noted in the instant Office action, lines 12-14 of claim 8 should be deleted. Applicants have deleted lines 12-14 of claim 8. Numbered paragraph 10 of the Office Action mailed 1/22/2004 also stated: The same applies to claims 9-11. Applicants believe that the changes to independent claim 8 corrects dependent claims 9-11.

Numbered paragraph 10 of the Office Action mailed 1/22/2004 stated: Claim 8 is also now indefinite because it is not clear what is meant by "the said" at 17. It is suggested that "the" be deleted for line 17. The same applies to claims 9-11. Applicants have deleted "the" in line 17 of claim 8 and in claim 9. Applicants believe that the changes to independent claim 8 corrects dependent claims 9-11.

Numbered paragraph 10 of the Office Action mailed 1/22/2004 stated: Claim 10 is now confusing because the limitation "wherein said electrodes comprise plates of interdigitated electrodes" at lines 1-2 is already present in parent claim 8 due to the fact that claim 8 has been amended so as to recite that the interdigitated electrodes have plates. It is suggested that the term "wherein said electrodes comprise plates of interdigitated electrodes and" be deleted from lines 1-2 of claim 10. The term has been deleted from lines 1-2 of claim 10 and claim 10 is believed to comply with the requirement of form set out in the Office Action and to overcome the 35 USC 112, second paragraph, rejection.

Provisional Double Patenting Rejection - Application 09/737,542

In numbered paragraph 12 of the Office Action dated 1/22/2004, claims 1-11 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-28 of copending Application No. 09/737,542. The Examiner pointed out that "this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented."

The conflicting application, Copending Patent Application No. 09/737,542, is commonly owned with the subject application. The Copending Patent Application No. 09/737,542 is assigned to "The Regents of the University of California" as shown by the recorded assignment. Applicants' subject patent application is assigned to "The Regents of the University of California" as shown by the recorded assignment.

A terminal disclaimer in compliance with 37 CFR §321(c) in the form of a "TERMINAL DISCLAIMER TO OBTAIN A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION" disclaiming the terminal portion of any patent granted on the subject application beyond the expiration date of any patent issued upon Copending Patent Application No. 09/737,542 is enclosed.

Provisional Double Patenting Rejection - Application 09/993,870

In numbered paragraph 13 of the Office Action dated 1/22/2004, claims 1-11 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 09/993,870. The Examiner pointed out that "this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented."

The conflicting application, Copening Patent Application No. 09/993,870, is commonly owned with the subject application. The Copening Patent Application No. 09/993,970 is assigned to "The Regents of the University of California" as shown by the recorded assignment. Applicants' subject patent application is assigned to "The Regents of the University of California" as shown by the recorded assignment.

A terminal disclaimer in compliance with 37 CFR §321(c) in the form of a "TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION" disclaiming the terminal portion of any patent granted on the subject application beyond the expiration date of any patent issued upon Copening Patent Application No. 09/993,870 is enclosed.

Provisional Double Patenting Rejection - Application 09/738,461

In numbered paragraph 14 of the Office Action dated 1/22/2004, claims 1-11 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all the claims of copending Application No. 09/738,461. The Examiner pointed out that "this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented."

The conflicting application, Copening Patent Application No. 09/738,461, is commonly owned with the subject application. The Copening Patent Application No. 09/738,461 is assigned to "The Regents of the University of California" as shown by the recorded assignment. Applicants' subject patent application is assigned to "The Regents of the University of California" as shown by the recorded assignment.

A terminal disclaimer in compliance with 37 CFR §321(c) in the form of a "TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE

PATENTING REJECTION OVER A PENDING SECOND APPLICATION"
disclaiming the terminal portion of any patent granted on the subject application
beyond the expiration date of any patent issued upon Copending Patent
Application No. 09/738,461 is enclosed.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims and the issues raised in the Office Action dated 1/22/2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



Eddie E. Scott
Attorney for Applicant
Registration No. 25,220
Tel. No. (925) 424-6897

Livermore, California
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